

REMARKS/ ARGUMENTS

At page 3 of the Official Action of November 8, 2005, claims 9, 11 and 13-15 were rejected under 35 U.S.C. 103(a) over Douglas-Hamilton et al (US Pat. 5,306,467) in view of Kapitza et al. This ground of rejection is courteously traversed.

Initially, Applicant wishes to highlight the fact, that contrary to the Examiner's opening remarks appearing in Section 9, second paragraph, Douglas-Hamilton et al do not teach a microscope stage. The device 10 of Douglas-Hamilton et al is a slide loading apparatus for use with either automated cell counting equipment or manual optical microscopes for measuring the number of cells in a fluid biological sample. The device of Douglas-Hamilton et al may be placed onto the stage of a microscope, but it is incorrect to categorize or imply Douglas-Hamilton et al's slide loading apparatus is a microscope stage in the absence of such a specific teaching that it is a microscope stage or is used in place of a microscope stage. Evidence that the device of Douglas-Hamilton et al is not a microscope stage is apparent from col. 5, lines 8-11 which teaches "In an alternative embodiment which is more conducive to use with manual microscopy, it becomes more important that the specimen is as close to the microscope condenser as possible in order to maintain the use of the full range of illumination optics."

The representation in the Office Action that Douglas-Hamilton et al teach an upper stage 10 is also incorrect, but instead 10 is a holder for a slide 21 with a recess 14 for accommodating the slide. A holder clamp 20 pivotally mounted to the slide holder is not a non-transparent contrasting stage insert, as stated in the Official Action, but instead is

disclosed as a retainer for slide 21 and coverslip 23 within recess 14.

During prosecution before the Patent and Trademark Office, claims are given their broadest reasonable interpretation consistent with the specification and the prior art. Compare *In re Finsterwalder* , 58 CCPA 871, 436 F. 2d 1028, 168 USPQ 530 (CCPA 1971). Also see *In re Sneed* , 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983). Note the operative word in the above stated rule of law is "reasonable". The slide loading apparatus of Douglas-Hamilton et al has nothing to do with the objective of creating a contrast between a microscope stage and a specimen, so the specimen can be properly oriented upon the stage prior to insertion into the optical path, according to Applicant's invention. The explanation of claim language by the Examiner, as discussed above, must bear some rational connection to the way the language is employed in Applicants' specification or to the meaning it would be given by a person of ordinary skill in the subject art. See, for example, *In re Gordon* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) The fact that Douglas-Hamilton et al teach a slide loading apparatus which can be placed onto the stage of a microscope, and includes a U-shaped holder clamp which enters a recess in the slide holder for retaining slide/specimen in place, has no bearing on Applicant's device, utility and objective of enabling a user to orient a specimen on a stage. Simply put, the device of Douglas-Hamilton et al has no relevance to Applicant's microscope stage, stage insert, etc.

In addition to the obvious shortcomings pointed out above in connection with Douglas-Hamilton et al, no rationale or convincing line of reasoning is provided in the Official Action teaching the incentive or basis for combining Kapitza et al with Douglas-Hamilton et al. *In re Geiger* 2 USPQ 2d 1276 (CA Fed

Cir. 1987), *Ex parte Clapp* 227 USPQ 972 (PTO BA 1985) The indiscriminant combining of references wherein elements of Applicants' claims selected on a pick n' choose basis to the exclusion of other elements in the cited art is specifically outlawed by 35 U.S.C. 103.

Here again, the utilities and objectives of Douglas-Hamilton et al are different from those of Kapitza et al.

Accordingly, reconsideration and withdrawal of the rejection of claims 9, 11 and 13-15 over Douglas-Hamilton et al (US Pat. 5,306,467) in view of Kapitza et al. are courteously requested.

At paragraph 10 of the Official Action, claim 10 was rejected under 35 U.S.C. 103(a) over Douglas-Hamilton et al in view of Kapitza et al. This ground of rejection is courteously traversed.

Once again, paragraph 10 of the Official Action attempts to portray the device of Douglas-Hamilton et al as a microscope stage when, in fact, it is **not** disclosed as a microscope stage. The invention of Douglas-Hamilton et al is disclosed as a slide loading device for use in cell counting systems or standard optical microscopes. According to Douglas-Hamilton et al clamp 20 was designed to exert uniform force on a coverslip so as to ensure a uniform volume or concentration of cells of a sample are on the slide. Furthermore, it remains unclear why the so called "non-transparent contrasting stage insert" according to the latest Official Action, which Douglas-Hamilton et al call clamp 20, should be painted when stage insert 11 of Kapitza et al is simply an unpainted transparent ceramic glass plate.

Hence, even if it were valid to combine the teachings of Kapitza et al with those of Douglas-Hamilton et al, which it is not, but even if it were, the subject matter of claim 10 would

still not be arrived at as to render the invention unpatentable under 35 U.S.C. 103(a), as alleged. Accordingly, reconsideration and withdrawal of the rejection of claim 10 for reasons of obviousness are courteously solicited.

At paragraph 11 of the Official Action, claim 12 was also rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al in view of Kapitza et al. This ground of rejection is courteously traversed.

The Official Action expressly acknowledges that neither of the cited references applied in rejecting the claims teach or suggest the use of adhesive film as the non-transparent contrasting stage insert, but nevertheless concludes it would be obvious to employ double-sided tape for this application.

However, the use of adhesive film in this application is not so well known as to take judicial notice of the same without the citation of published prior art. Accordingly, in the event the rejection of claim 12 is maintained, it is courteously requested the Examiner furnish an appropriate prior art citation to support the conclusion of obviousness. Otherwise, the rejection should be withdrawn.

At paragraph 12 of the Official Action of November 8, 2005, claims 1-5 were rejected under 35 U.S.C. 103(a) as unpatentable over Douglas-Hamilton et al in view of Kapitza et al. This ground of rejection is courteously traversed.

Once again, the rejection in referring to Douglas-Hamilton et al calls holder clamp 20 employed for applying uniform pressure to a coverslip to achieve a uniform volume of a sample on a slide, as being the equivalent of a non-transparent stage insert, which it is not. A clamp for applying pressure to a coverslip according to Douglas-Hamilton et al, contrary to the Official Action, is not the equivalent of Applicant's non-

contrasting stage insert, or the equivalent of Kapitza et al's transparent ceramic insert 11.

Notwithstanding, the Official Action urges it would be obvious to disengage the lateral extensions on the legs of the stage insert 20 from the bores of the recesses of the upper stage to arrive at Applicants' claimed invention. Here again, the Examiner is incorrectly treating the device of Douglas-Hamilton et al as a microscope stage, when it is a slide loading device for cell counting systems, whereas clamp 20 used as a means for applying uniform pressure to a coverslip is said in the Official Action to be the equivalent of Kapitza et al's ceramic insert 11. Ceramic insert 11 does not apply uniform pressure to a specimen, as required of the clamp of Douglas-Hamilton et al. That is, Kapitza et al's insert is not interchangeable with clamp 20 of Douglas-Hamilton et al's slide loading device because the insert of Kapitza et al does not apply pressure, as required by Douglas-Hamilton et al. Furthermore, the Official Action is incorrectly treating the pivotally mounted clamp 20 of Douglas-Hamilton et al as a stage insert which component fails to meet the criteria of Applicants' claimed invention with regard to "non-transparent contrasting stage insert", as claimed.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-5 under 35 U.S.C. 103(a) as obvious over Douglas-Hamilton et al in view of Kapitza et al are courteously solicited.

At paragraph 13 of the Official Action, claim 6 was rejected for reasons of obviousness over Douglas-Hamilton et al in view of Kapitza et al, as applied to claims 1, 4, and 9 above, and further in view of Fischer et al (US Pat. 4,436,385). This ground of rejection is courteously traversed.

Douglas-Hamilton et al in combination with Kapitza et al fail to make out a *prima facie* case of obviousness of Applicants' microscope stage which includes *inter-alia* an upper stage with a recess and non-transparent contrasting stage insert for the recess having color different from the color of the upper stage, wherein the contrasting stage insert comprises a releasable fastening means which is a detent. Contrary to the Official Action, Douglas-Hamilton et al do not disclose a microscope stage having structural features which meet the criteria of Applicants' claim 6, such as a non-transparent contrasting stage insert, but instead employs a clamp 20 which applies uniform force on a coverslip on a slide in a slot of a slide loading device for cell counting systems for optical microscopes with microscope stages. As pointed out above, during prosecution before the Patent and Trademark Office, claims are given their broadest reasonable interpretation consistent with the specification and the prior art. However, there is no relationship between the structural features of the slide loading device of Douglas-Hamilton et al and that of Kapitza et al relative to Applicants' claimed device, as pointed out above.

Furthermore, the detents of Fischer et al are spring wires intended and used for rapid adjustment (spacing) of plates 2a and 2b which operate to retract the V-shaped indentations, while preventing too easy opening of the jaws formed by the plates. That is, the detents of Fischer et al are not "releasable fastening means" according to Applicants' claim 6, but instead operate as spring means for controlling the spacing of the V-shaped plates to avoid inadvertent dropping of specimen slides (See col. 2, lines 3-8 of Fischer et al).

Accordingly, while Fischer et al teach the use of springed detents, this structural feature lacks the "releasable"

properties associated with Applicants' detent, and therefore, fails to meet the limitations of claim 6. Finally, it is impermissible within the framework of 35 U.S.C. 103 to pick n' choose structural feature(s) from a collection of references, including Fischer et al cited to meet the limitation of claim 6, and exclude other features of the reference because they are not needed. That is, the selection of the detent of Fischer et al to the exclusion of other elements of the device of Fischer et al is clearly a violation of the rule against hindsight reconstruction where the invention becomes obvious after having the benefit of a prior reading of Applicants' own disclosure. Otherwise, why was the detent selected exclusively from the prior art.

Accordingly, the combination of Douglas-Hamilton et al, Kapitza et al and Fischer et al fail to make out the requisite *prima facie* case of obviousness under 35 U.S.C. 103(a). Reconsideration and withdrawal of the rejection of Claim 6 are courteously solicited.

In paragraph 14, claims 17-20 were rejected under 35 U.S.C. 103(a), as unpatentable over Douglas-Hamilton et al in view of Sattler (US Pat. 4,906,083). This ground of rejection is courteously traversed.

As previously discussed, the device of Douglas-Hamilton et al is not a microscope stage, as alleged, but instead performs and contains structural features specifically designed for measuring cell concentration in a biological specimen. The device is seated on a microscope stage, as discussed above and not used in place of a stage. It is erroneous to correlate, for example, holder clamp (20) of Douglas-Hamilton et al with Applicant's non-contrasting stage insert because Applicant's non-contrasting stage insert is not designed or disclosed as

possessing the property of applying and exerting uniform pressure on the edges of a coverslip overlying a specimen volume. This is a key feature of Douglas-Hamilton et al's device, that is neither used nor needed according to Applicant's invention. As previously stated, the Patent and Trademark Office, in the process of examining claims, the claims are given their broadest reasonable interpretation consistent with the specification and the prior art, and the selection of Douglas-Hamilton et al's device as meeting the limitation's goes well beyond the "broadest reasonable interpretation" standard in extending the specific structural features of the slide loading device of Douglas-Hamilton et al to the structural features of Applicant's claims 17-20. Hence, even if Sattler teaches the features wherein the gemstones may have a color different from a microscope stage, as alleged in the Official Action, Claims 17-20 would still not be arrived at because the structural features of the slide loading device of the Douglas-Hamilton et al simply do not meet the criteria of Applicants' claims.

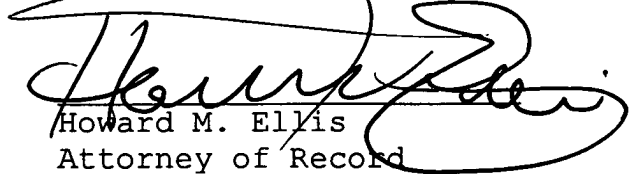
In view of the foregoing discussion, reconsideration and withdrawal of the rejection of claims 17-20 as unpatentable over Douglas-Hamilton et al in view of Sattler are courteously requested.

In the foregoing discussion, a strenuous and sincere effort has been made to identify and distinguish the structural features of the claimed invention over the cited references. The language of the claims does clearly distinguish over the art of record, so as to place this application in condition for allowance. Notification of the same at an early date is

earnestly solicited.

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Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Howard M. Ellis", written over a horizontal line.

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